



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/778,711	02/07/2001	Tomoji Asada	450100-02994	4182

20999 7590 04/22/2005

FROMMER LAWRENCE & HAUG  
745 FIFTH AVENUE- 10TH FL.  
NEW YORK, NY 10151

EXAMINER

TRAN, THAI Q

ART UNIT PAPER NUMBER

2616

DATE MAILED: 04/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/778,711

Applicant(s)

ASADA ET AL.

Examiner

Thai Tran

Art Unit

2616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 February 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Specification***

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Itoh et al (US 6,700,989 B1) in view of Liebenow (US 6,601,074 B1).

Regarding claim 1, Itoh et al discloses a receiving system (Fig. 27) composed of a receiving device, a monitor device for displaying an output of said receiving device,

Art Unit: 2616

and an external recording device to be controlled by said receiving device, said receiving device comprising:

external device control means (a readout/reception device 80 of Fig. 27, col. 31, lines 29-61) for setting an operation of said external recording device; and

control means (a readout/reception device 80 of Fig. 27, col. 31, line 29 to col. 32, line 59 and col. 34, lines 55-65) for, when a recording input is given, determining whether or not a program being received is copy protected, setting said external recording device to a recording state if said program is found not copy protected, and disabling control said external recording device if said program is found copy protected. However, Itoh et al does not specifically disclose on-screen display control means for displaying a screen corresponding to various setting states and setting items on said monitor device in an on-screen manner.

Liebenow teaches that the program can be requested for recording using the electronic program guide (EPG) (Fig. 2, col. 3, lines 18-39 and from col. 4, line 66 to col. 5, line 57).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the capability of requesting a program to be recorded by using electronic program guide as taught by Liebenow into Itoh et al's system in order to simplify the process of requesting program to be recorded.

Regarding claim 2, the proposed combination of Itoh et al and Liebenow discloses all the claimed limitations as discussed above with respect to claim 1 except for providing the claimed wherein, if said program is found copy protected when

Art Unit: 2616

said recording input is given, a warning indicative of copy protection is displayed in an on-screen manner.

The capability of displaying a warning indicative of copy protection on an on-screen display device is old and well known in the art and; therefore, Official Notice is taken.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the well known displaying a warning indicative of copy protection on an on-screen display device into Itoh et al's system in order to notify the user that the program can not be recorded so that the user can determine whether to record the program again.

Regarding claim 3, Itoh et al also discloses the claimed wherein, when said recording input is given, an on-screen display is provided through which stop of recording is operated (col. 31, lines 29-40 and col. 34, lines 55-65).

Regarding claim 4, Itoh et al discloses the claimed wherein, when said recording input is given, a button for stopping recording is put in a selected state on said on-screen display (col. 31, lines 29-40 and col. 34, lines 55-65).

Regarding claim 5, Liebenow teaches the claimed wherein said external device control means controls said external recording device by use of an AV mouse (the mouse disclosed in col. 3, lines 2-17).

Regarding claim 6, the proposed combination of Itoh et al and Liebenow discloses all the claimed limitations as discussed above with respect to claim 1 except for providing the claimed wherein said external device control means controls said

Art Unit: 2616

external recording device by use of an IEEE 1394 interface.

Itoh et al also disclosed in col. 2, lines 45-55 the well known IEEE1394 interface.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the well known IEEE 1394 into the combination of Itoh et al and Liebenow in order to increase the transmitting speed of the data because IEEE 1394 has high transfer speed.

Claims 7-12 are rejected for the same reasons as discussed in claims 1-6 above.

Method claims 13-18 are rejected for the same reasons as discussed in apparatus claims 1-6 above.

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The cited references relate to copy protecting of audio/video program.

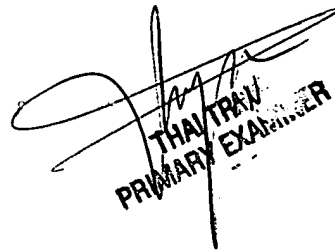
5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thai Tran whose telephone number is (571) 272-7382. The examiner can normally be reached on Mon. to Friday, 8:00 AM to 5:30 PM.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2616

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TTQ

  
THAI TRAI  
PRIMARY EXAMINER